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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,633	01/12/2001	Leping Li	018781-003810	2302
20350	7590	10/03/2003	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SMALL, ANDREA D SOUZA	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,633	Applicant(s)	
	Examiner Andrea D Small	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-12, 14-23 and 25-33 is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10/1 2/2</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are parts of 1-12, 14-23, 25-33 and claims 13, 23 and 34 .

DETAILED ACTION

I. Preliminary Matters:

- (a) Applicants response filed 07/21/2003 has been received and entered into the file.
- (b) An information disclosure statement filed 10/01/2001 and 02/26/2002 have been received and entered into the file. A signed and initialed copy of the 1449 is attached to the instant office action.
- (c) Claims 1-34 is pending.

II. Restriction/Election:

- (a) Applicants have elected to prosecute the compound of Example 31, page 30 of the specification. The applicant's election was made with traverse; the traversal is held in abeyance pending the identification of the elected group by the Examiner.

- (b) The elected group is as follows:

The compound and its method of use having the formula:

A-X-M-Y-B, wherein:

A is a phenyl substituted by -NR₁₆R₁₇, wherein R₁₆ and R₁₇ are combined with the N atom to which each is attached to form a five-membered ring optionally having additional substituents selected from the group consisting of (C1-C8)-alkyl, hydroxy, methoxymethyl, dimethylamino, (C1-C8)-heteroalkyl and phenyl;

B is an optionally substituted phenyl;

X and Y are each independently a bond; and

M is C=U-NR₇, wherein U is =N-OR₁₀, wherein R₁₀ is as claimed and R₇ is as claimed.

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The claims that read on the elected group as identified supra are claims 1-12, 14-23 and 25-33.

The remaining subject matter of claims 1-12, 14-23 and 25-33 that do not read on the elected group as identified supra along with claims 13, 24 and 34 are withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

(c) This restriction is proper as examining the non-elected subject matter with the elected subject matters as identified supra would impose a serious burden on the office because the elected subject matter is classified in 548/577, while the subject matter of the non-elected subject matter is variously classified, for example the piperidine species is classified in 546/184, the piperazine species is classified in 544/358, the azetidine species is classified in 548/950, etc. Searching this myriad of classes and subclasses plus performing a separate electronic database search which are not co-extensive and involve separate searching strategies would impose a serious burden on the office if these classes of compounds were to be examined in one application. Therefore, restriction between these classes of compounds is proper and maintained.

III. Objections:

Claims 1-12, 14-23 and 25-33 in part are objected to as containing non-elected subject matter and would appear allowable if limited solely to the elected group as identified supra.

IV. Contact Information:


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small whose telephone number is (703) 305-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:30-6:30 PM. The number for accessing the facsimile machine is (703) 746-4984.

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Andrea D. Small, Esq.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

September 29, 2003